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JL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,108 05/27/99 BERGHOFER

J 99.186

IM22/0725

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EXAMINER

HARDEE, J

ART UNIT	PAPER NUMBER
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1751

DATE MAILED:

07/25/00

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/319,108	Applicant(s) Berghofer et al.
Examiner John R. Hardee	Group Art Unit 1751

- Responsive to communication(s) filed on _____
 This action is FINAL.
 Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- Claim(s) 1-19 and 23-25 is/are pending in the application.
Of the above, claim(s) 7-9, 13, 14 and all non-elected inventions is/are withdrawn from consideration.
 Claim(s) 1-6, 10-12, 15-18, and 23-25, elected invention only is/are allowed.
 Claim(s) 19 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 5
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1751

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that no basis was given for dividing the claims into ten inventions and because all of the inventions fall into the same class and subclass, and therefore do not impose an undue burden. This is not found persuasive because the restriction was made under unity of invention practice which does not require that reasons be given. However, the ten-way restriction was made because, in the examiner's opinion, ten patentably distinct inventions were recited in the claims based on the combinations of R groups outlined in the restriction requirement. Furthermore, all of the inventions do not fall out in 562/125. The ester and sulfonic acid functional groups, inter alia, make a number of the inventions fall into classes prior to class 562, including the elected invention, which falls in Class 560.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1751

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What does applicant mean by "customary additives and auxiliaries?"

Allowable Subject Matter

4. Claims 1-6, 10-12, 15-18 and 23-25 are allowable, to the extent that they read on the elected invention.

5. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record is the Mulliez reference, submitted by applicant, or JP 03-085108. The Mulliez reference discloses the preparation of alphahydroxysulfinate. The JP discloses the sodium salt of hydroxysulfoacetic acid. Neither reference discloses alphahydroxysulfinic acids of the form elected by applicants. Accordingly, applicant's elected invention is patentable over the prior art of record.

6. The prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 7:30 until 4:00. In

Art Unit: 1751

the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



JRH

July 24, 2000

Lorna M. Douyon
LORNA M. DOUYON
PRIMARY EXAMINER